

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/15/2010 has been entered.

Claims 1-3, 5, 8, 10, and 11 are pending.

Claim 11 is newly added.

Claims 1-3, 5, 8, 10, and 11 are currently under consideration.

Withdrawn Rejections

The rejection of claims 6, 7, and 9 under 35 U.S.C. 103(a) as being unpatentable over Gruning et al (U.S. Patent number 6,242,499) is withdrawn in view of Applicant's cancellation of said claims.

Rejections maintained and Made Again

Note: Rejections of claim 11 are necessitated by amendment

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gruning et al (U.S. Patent number 6,242,499, Patent issued Jun. 5, 2001).

Gruning teaches a polyglycerol ester that is prepared in two stages. The polyglycerol, which includes diglycerol (diglycerin), is esterified using fatty acid, and then isostearic acid is mixed with the polyglycerol. The composition is heated to 250°C for three hours. The reaction mixture is then cooled to 180°C and is mixed with a dimer acid. The composition is then heated again to 250°C for three hours. An amber-colored viscous product is obtained which is characterized by a hydroxyl number of 68 and an acid number of 1.5 (see column 4, lines 46-62), this reads on **instant claim 5**.

Gruning fails to directly teach the viscosity of the composition. Gruning also fails to directly teach the molar ratios between the components. Furthermore, Gruning fails to directly teach the molecular weight of the composition.

With regard to the viscosity of **instant claim 8**, it is noted that Applicant identifies in the specification, on the paragraph that bridges pages 8 and 9, that by controlling the hydroxyl or acid value “it is possible to easily control the viscosity and the hydroxyl value of the desired hydroxyl compound in the reaction of the ester compound obtained in the first step with a predetermined amount of dimer acid in the second step”. It is noted that the hydroxyl value *and* the acid value are similar to the hydroxyl and acid values of example 4 on page 20 of the instant specification. It is noted that the instant specification teaches that it is easy to control the viscosity (see end of paragraph bridging pages 8 and 9 of the specification). It is furthermore noted that Applicant has shown in table 1 that the instant compositions with the specified

viscosities have a hydroxyl value that is between 30 and 80, the composition of Gruning teaches a composition of a hydroxyl value of 68 (see column 4, lines 46-62). Furthermore, the composition is taught as being made by a similar, if not the same method. The instant composition is made by combining the diglycerin and isostearic acid at a temperature of between 180 and 250°C for about 3 to 40 hours, then said dimer is combined with said newly formed ester at a temperature of 150 to 330°C and the acid value of the composition is allowed to be preferably at most 3.0 (see instant specification, page 8, lines 16-30). In Gruning, the polyglycerol and isostearic acid are combined at a temperature of 250°C for 3 hours, then said dimer is combined with said newly formed ester at a temperature of 250°C and the acid value of the composition is 1.5 (see column 4, lines 46-62). Therefore, the viscosity of the composition of Gruning would have been within the claimed ranges since the composition comprises the same components, is reacted in the same way, and has the same hydroxyl and acid values.

With regard to the molar ratios and molecular weight of **instant claims 1-3 and 10**, the exact molecular weight of the polyglycerol component is not directly taught. Gruning teaches that a particularly suitable polyglycerol contains 0-30% glycerol, 15-40% diglycerol, 10-55% triglycerol, 2-25% tetraglycerol, and 0-15% pentaglycerol and higher (see column 3, lines 25-31). It would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the molecular weight of the composition, and the molar ratio of the components. One would have been motivated to vary the molar ratio of the components in order to arrive at a desirable amount of esterification. Furthermore, the molecular weight of the composition depends on the intended use and is readily varied. It is noted the discussion above with regard to claims 6-8 wherein it is identified that both the instant claims and Gruning are teaching a

composition with the same components, reacted in the same way, with the same hydroxyl values, and the same acid values, wherein it is also noted that both compositions are being used in cosmetics. It is further noted that MPEP 2144.05 states: "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)."

With regard to newly added claim 11, specifically, with the newly added recitation of a "lipstick composition", Applicant is reminded that the intended use of a product claim carries no patentable weight. See MPEP 2111.02. Thus, the intended use of the hydroxyl compound as a lipstick is given no patentable weight.

Response to Arguments

Applicant argues in the response filed 03/15/2010 that Gruning fails to teach the instant invention, since, as can be seen by Comparative Example 1 in the instant specification, a composition with such as that taught in Comparative Example 1 would not have the claimed features, such as hydroxyl value. Applicant's arguments are not found persuasive since, as stated in the Final Rejection (10/14/2009) and the Advisory Action (02/26/2010), "Gruning teaches a polyglycerol ester that is prepared in two stages. The polyglycerol, which includes diglycerol (diglycerin), is esterified using fatty acid, and then isostearic acid is mixed with the polyglycerol. The composition is heated to 250 Centigrade for three hours. The reaction mixture is then cooled to 180 Centigrade and is mixed with a dimer acid. The composition is then heated again to 250

Centigrade for three hours. An amber-colored viscous product is obtained which is characterized by a hydroxyl number of 68 and an acid number of 1.5 (see column 4, lines 46-62)". Applicant's attention is drawn to the last sentence of the quoted portion above, specifically, the "hydroxyl number of 68". Applicant's arguments are based on the composition of Gruning being analogous to those of Comparative Example 1 from the instant specification. As can be clearly seen from the hydroxyl value of Gruning when compared to that of Comparative Example 1, the compositions of Gruning and Comparative Example 1 are in no way equivalent. Applicant correctly identifies that a hydroxyl value of 110.3 falls outside of the instant range set forth in claim 1, however, the hydroxyl value of Gruning (68) is within the claimed range of 30 to 80.

In view of Gruning teaching ratios which are close to those of the instant invention, and the hydroxyl value being within the claimed range, it is the position of the Examiner that Gruning is closer prior art than those in the Comparative Preparation Examples, therefore Applicant's arguments are not found persuasive. Applicant's attention is drawn to MPEP 716.02(e) which discusses comparison with the closest prior art. It is further noted that in Applicant's examples, the rating system "G", "M", and "B" are utilized. Though said rating system is utilized for a plurality of features, the empirical difference between a rating of "G" and a rating of "M" in many of the uses has not clearly been set forth. For instance, the water-holding test (instant paragraph [0051]) provides an empirical measure for "G" and "M", however, the compatibility test (instant paragraph (0052) uses relative terminology such as "high" and "slight". Therefore, in many of the examples, it is unclear how the instant invention is distinguishing from the comparative examples in situations where relative terminology is being relied upon.

Conclusion

No claims allowed. All claims rejected. No claims objected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVOR M. LOVE whose telephone number is (571)270-5259. The examiner can normally be reached on Monday-Thursday 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TL

/David J Blanchard/
Primary Examiner, Art Unit 1643